

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 16

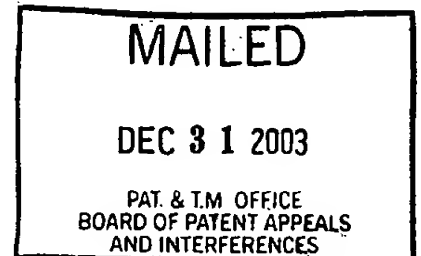
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CETIN NMI KAYA

Appeal No. 2003-1564
Application No. 09/620,649

ON BRIEF



Before OWENS, DELMENDO, and PAWLIKOWSKI, Administrative Patent Judges.

DELMENDO, Administrative Patent Judge.

DECISION ON REHEARING

This is in response to the appellant's request for rehearing (request) pursuant to 37 CFR § 1.197(b) (2003) (effective Oct. 10, 1997), filed on Nov. 17, 2003 (paper 15), of our Oct. 23, 2003 decision (paper 14).¹ In our original decision, we affirmed the examiner's rejections under: (i) 35 U.S.C. § 102(e) of appealed claims 12, 13, 15, and 16 as

anticipated by U.S. Patent No. 6,001,689 issued to Van Buskirk et al. (Van Buskirk) on Dec. 14, 1999; (ii) 35 U.S.C. § 103(a) of appealed claims 18 and 19 as unpatentable over Van Buskirk in view of U.S. Patent No. 5,926,711 issued to Woo et al. (Woo) on Jul. 20, 1999; and (iii) 35 U.S.C. § 103(a) of appealed claims 14 and 17 as unpatentable over Van Buskirk in view of U.S. Patent No. 6,051,467 issued to Chan et al. (Chan) on Apr. 18, 2000.

For the first time in this appeal, the appellant relies on Pfaff v. Wells Electronics Inc., 525 U.S. 55 (1998) for the proposition that 35 U.S.C. § 102(b) does not require an "invention" to be reduced to practice. Specifically, the appellant asserts (unnumbered pages 1-2):

Subsequent to filing of the Brief on Appeal and the Reply Brief in the subject appeal, counsel for appellant became aware of the decision by the United States Supreme Court in Pfaff v Wells Electronics, 525 U.S. 55, 48 U.S.P.Q.2d 1641 (U.S. 1998) wherein the meaning of the term "invention" was specifically defined as it applies to 35 U.S.C.

It is clear from reading 35 U.S.C. that the word "invention" in the statute "does not contain any express requirement that an invention must be reduced to practice" as stated in Pfaff and even in section 102(g) where the conception and reduction to practice are specifically mentioned, there is no requirement that these be the only factors considered. If [sic] follows, first, that 35 U.S.C. nowhere define

¹ The appellant's originally filed request for rehearing was unsigned, but this was later corrected by facsimile on December 16, 2003.

"invention" by a determination solely of the questions of reduction to practice or conception with diligence up to a reduction to practice (actual or constructive). While a proper showing of a reduction to practice or conception with diligence up to a reduction to practice does establish invention under 35 U.S.C., there is nothing in 35 U.S.C. which limits the definition of invention to only those factors. This is confirmed in *Pfaff* wherein the Court rejected the longstanding precedent set forth above by stating [III] "*Pfaff* nevertheless argues that longstanding precedent buttressed by the strong interest in providing inventors with a clear standard identifying the onset of the 1-year period, justifies a special interpretation of the word 'invention' as used in § 102(b). We are persuaded that this nontextual argument should be rejected."

The appellant then argues (unnumbered pages 3-4):

In the present appeal, the specification in the provisional application Serial No. 60/060,561 is substantially identical to the specification in the subject application on appeal. There has never been any question of sufficiency of disclosure of the claimed invention in the prosecution of the subject application. If [sic] follows that the subject application contains a disclosure which is ready for patenting as defined by the Supreme Court in *Pfaff* and that appellant is entitled to rely at least upon the filing date of his provisional application (an [sic] possibly an earlier date if it can be established).

The appellant's new argument based on *Pfaff* is not appropriate in this rehearing and is therefore unavailing. Argument or evidence presented in a request for rehearing, but not in the appeal brief or reply brief, is not properly before the Board of Patent Appeals and Interferences and will not be considered. In re Kroekel, 803 F.2d 705, 708, 231 USPQ 640, 642

(Fed. Cir. 1986); Moller v. Harding, 214 USPQ 730, 731 (Bd. Pat. App. & Int. 1982), aff'd, 714 F.2d 160 (Fed. Cir. 1983); Ex parte Hindersinn, 177 USPQ 78, 80 (Bd. App. 1971); Ex parte Harvey, 163 USPQ 572 (Bd. App. 1968).

In this regard, the pertinent regulation, namely 37 CFR § 1.192(a) (2003) (effective Dec. 1, 1997), states: "Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown." While the appellant alleges that counsel for appellant became aware of the Pfaff decision after the appeal brief and reply brief (request, page 1) were filed, we note that the Pfaff decision was rendered in 1998, well before the present appeal was taken.

Even if we were to assume that the appellant's argument based on Pfaff was timely and thus appropriate in this rehearing, we see no need to modify our decision. The question before the Supreme Court in Pfaff was "whether the commercial marketing of a newly invented product may mark the beginning of the 1-year period [set forth in 35 U.S.C. § 102(b)] even though the invention has not yet been reduced to practice." Pfaff, 525 U.S. at 57. The Court held that the on-sale bar applied because, before the "critical date," (1) the product was the

subject of a commercial offer for sale and (2) the invention was ready for patenting. Id. at 67.

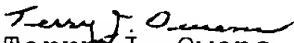
Thus, Pfaff has little, if any, relevance to the facts of the present case. That is, Pfaff did not address 37 CFR § 1.131 (2003) (effective Nov. 29, 2000). In the present case, the examiner relied on a reference available as prior art under 35 U.S.C. § 102(e) (Van Buskirk). In rebuttal, the appellant alleged that the requirements of 37 CFR § 1.131 (2003) (effective Nov. 29, 2000) have been met to effectively antedate the reference. As discussed in our original decision, the appellant has not satisfied the requirements of 37 CFR § 1.131.

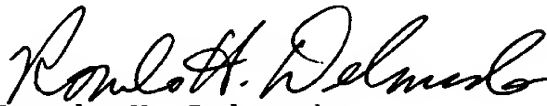
In summary, the appellant's request is granted to the extent of reconsidering our original decision but is denied with respect to making any substantive changes thereto.


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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

DENIED


Terry J. Owens)
Administrative Patent Judge)


Romulo H. Delmendo) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
INTERFERENCES)


Beverly A. Pawlikowski)
Administrative Patent Judge)

RHD/kis

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